Montecatini and Monaco could not go to the Court of Customs and Patent Appeals because they are foreigners. They must go on appeal for a *de novo* trial to the United States District Court of the District of Columbia and its Court of Appeals under Section 146 of the Patent Code. This case of Montecatini and Monaco is now pending in that court awaiting trial, *Monaco et al v. Hoffman*, Civil Action No. 2026-58. The District Court and Court of Appeals of the District of Columbia, Judge Burger dissenting, held that the Patent Office need not withhold the issuance of the patent. *Monaco and Montecatini v. Watson*, No. 14,937. Therefore, the Patent Office can immediately issue the patent to Hoffman, the winner in the Patent Office proceeding.

This would result in two patents being issued for the same invention.

B. PRACTICAL ASPECT.

The United States Courts have enough trouble with one patent at a time on one invention without complicating the situation by having two patents issued by the Patent Office for the same invention. The position of the Patent Office, as taken in the Courts of the District, would result in a disastrous and confusing situation.

C. PURPOSE OF THIS PETITION.

The purpose of this petition is to reverse the District Court of Columbia so that the Commissioner of Patents will be restrained from issuing an illegal patent to Hoffman, the American, until the question can be finally settled by the United States District Court of the District of Columbia and the United States Court of Appeals of the District of Columbia, as to who is the first and true inventor, in the only tribunal open to a foreigner. (35 U. S. C. § 146.)

REASONS FOR GRANTING THE WRIT.

The writ of certiorari is requested in this case for the following reasons:

1. The Court of Appeals for the District of Columbia has rendered a decision in conflict with a decision of the Court of Customs and Patent Appeals.

The Court of Customs and Patent Appeals has held that the Commissioner of Patents does not have jurisdiction to issue a patent while an appeal is pending in that Court. *In re Allen*, 115 F. 2d 936, 28 CCPA 792 (1940). That was recognized by both the majority and dissenting opinion in the Court below.

A foreigner is forced to go to the United States District Court under Section 146 of the Patent Code: That decision by Congress should not deprive him of the same rights that he would have had if he had gone to the Court of Customs and Patent Appeals, i.e. the withholding of a patent to his opponent when the case goes up for court review of the Patent Office decision.

The majority opinion in the Court below distinguishes the *Allen* case on ground that a proceeding for review by a District Court is a proceeding "de novo and not an appeal." The only difference between an appeal to the Court of Customs and Patent Appeals (under 35 U. S. C. § 141) and a proceeding for review by a district court (under 35 U. S. C. § 146) is that the scope of review by a district court is broader.

The two methods of review correspond to review by writ of error at common law and the appeal in equity. See 2 *Am. Jur.* 843-844 (Appeal and Error § 2). As the Court held in *Simmons v. Stern*, 9 F. (2d) 256 (C. C. A. 8, 1925):

> "An appeal in equity is a trial de novo. Dower v. Richards, 151 U. S. 658, 663, 14 S. Ct. 452, 38 L. Ed. 305; Central Improvement Co. v. Cambria Steel Co.,

210 F. 696, 700, 127 C. C. A. 184; Anderson v. Hultberg, 247 F. 273, 279, 159 C. C. A. 367; Emerson Brantingham Implement Co. v. Johnson (C. C. A.) 1 F. (2d) 212."

The dissenting opinion in the Court below states:

"For purposes of the Commissioner's interim jurisdiction I can see no difference between an appeal to the CCPA under 35 U. S. C. § 141 and a suit for review in a District Court under 35 U. S. C. § 146."

2. The Court of Appeals for the District of Columbia has decided a question of Constitutional Law which has not been, but should be, settled by this Court.

The Constitution limits a patent monopoly to the correct inventor or inventors of a single patent. Const., Art. I, § 8, Cl. 8. Therefore, issuing two patents for the same invention to different inventors is unlawful. *The public gives up enough when a monopoly is granted to one inventor and should not be burdened with dual monopoly.*

If a patent is issued to the winning party to an interference, and the loser is ultimately successful in the Courts, *there will be two patents outstanding* on the same invention. Although 35 U. S. C. § 135 provides for the cancellation of claims from a patent if the losing party to an interference is ultimately successful, that is not tantamount to cancellation of the patent. The patent is still outstanding, and claims which do not read directly on the counts of the interference are unaffected. Where the patent is withheld pending review of an interference proceeding, the Patent Office will re-examine the claims allowed in the light of the Court's decision. *Smith v. Watson*, 318 F. (2d) 863; *U. S. Rubber Co. v. Coe*, 146 F. 2d 315.

The majority of the Court below held that 35 U. S. C. § 135 authorizes the Commissioner to issue a patent while

a proceeding for review is pending in a District Court. *That statute makes no distinction between appeals to the Court of Customs and Patent Appeals and proceedings for review by a District Court.* After the statute was enacted the Patent Office at first construed it as authorizing the withholding of the patent in both instances. *Dunn v. Ragin v. Carbide*, 50 USPQ 464 (1941). The decision in *In re Allen*, 115 F. (2d) 936 (CCPA 1940) compelled the Commissioner to withhold the patent when an appeal was taken to that Court. As the dissenting Judge Burger stated in the Court below:

> "This statute clearly makes no distinction between the two routes for review, nor does reason suggest why any such distinction should be made."

3. The decision of the Court of Appeals for the District of Columbia calls for an exercise of this Court's power of supervision.

It is universally recognized that, when an appeal is taken from a trial court or administrative agency, the tribunal from which the appeal is taken can proceed no further with the case because jurisdiction over the action has been transferred to the appellate court. 3 *Am. Jur.* 192 (Appeal and Error, Sec. 528); *In re Allen*, 115 F. (2d) 936 (CCPA 1940).

Moreover, either a trial or appellate court may issue orders to preserve the status quo while a case is pending. *Scripps-Howard Radio v. Federal Communications Commission*, 316 U. S. 4, 86 L. Ed. 1229, 62 S. Ct. 875 (1942); *Natural Gas Pipeline Co. v. Federal Power Commission*, 128 F. (2d) 481 (CCA 7, 1942).

The rule which was followed in those cases has been adopted by the Administrative Procedure Act. Section 10(d) of the Administrative Procedure Act (5 U. S. C.

§ 1009(d)) authorizes every reviewing court to issue necessary orders "to postpone the effective date of any agency action or to preserve status or rights pending conclusion of the review proceedings."

CONCLUSION.

For the foregoing reasons, the writ of certiorari should be granted. We believe the propriety of granting the writ in this case is apparent from the dissenting opinion in the court below.

Respectfully submitted,

HARRY A. TOULMIN, JR.,
Counsel for Petitioner.

GEORGE W. STENGEL,
Of Counsel.